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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,133	06/01/2005	Malcolm Tom McKechnie	102792-450 (10477P1)	2800
27389 7590 05/28/2009 NORRIS, MCLAUGHLIN & MARCUS 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022			EXAMINER AHMED, HASAN SYED	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 05/28/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,133	Applicant(s) MCKECHNIE, MALCOLM TOM	
	Examiner HASAN S. AHMED	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-15 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-15, and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of applicant's amendment and remarks, filed on 30 January 2009; and RCE, filed on 2 March 2009.

* * * * *

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 January 2009 has been entered.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-13, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,139,864 ("Lindauer") in view of U.S. 2003/0091466 ("Benko"), further in view of WO 94/23765 ("Duterloo"). All references are cited in applicants' IDS filed on 6 May 2005.

Lindauer teaches a multilayer volatilizable substance delivery article (see col. 2, line 62 – col. 3, line 18). The disclosed article is comprised of:

- a first phase consisting of a vaporizable agent (i.e. pockets of perfume material) as recited by instant claims 1 and 2 (see col. 9, lines 26-35, figure 11 (107));
- a second phase consisting of a second vaporizable material, as recited by instant claims 1 and 2 (see col. 9, lines 37-43; figure 11 (103));
- a third phase which constitutes a barrier between the first and second phases, as recited by instant claims 1 and 2 (see col. 9, lines 31-35; figure 11 (101));
- the commencement of vaporization of the second phase being delayed by the third phase and the flowing of the second phase around the third phase, as recited by instant claims 1 and 2 (see col. 7, line 65 – col. 8, line 4; figure 2);
- the shrinking of the third phase, as recited by instant claim 1 (see col. 7, line 65 – col. 8, line 4; figure 2);
- the third phase being the gel, as recited by instant claims 1 and 2 (see col. 9, line 37; figure 11 (101));
- the fragrance as recited by instant claim 11 (see col. 2, line 64);
- the insect repellant as recited by instant claim 12 (see col. 2, line 65);
- the third phase being the evaporable agent as recited by instant claim 13 (see col. 7, lines 64-68; figure 2); and

- the third phase being the gel whose volume reduces when exposed to air as recited by instant claims 1 and 2 (see col. 7, lines 64-68; figure 2);

Lindauer explains that a multilayer multifunctional volatizable substance delivery article is beneficial because it can deliver different substances (i.e. different aroma profiles) to the environment in a sequentially timed fashion (see col. 2, line 66 – col. 3, line 5).

The Lindauer reference differs from the instant application in that it does not teach the first or second phases to be liquid or gel phases.

Benko, et. al. teach an apparatus for releasing fragrance (see paragraph 0023). The apparatus may comprise multiple liquid or gel phases (see paragraph 0027, figure 3).

The Lindauer reference differs from the instant application in that it does not teach the partition wall of instant claim 1. Dunterloo teaches an article comprising an upper liquid (see page 7, lines 7-14, fig. (2)), a different lower liquid (see page 7, lines 7-14, fig. (4)) and a third liquid (see page 7, lines 7-14, fig. (10)), which differs from the upper and lower liquids. The article comprises an inner holder (see page 7, lines 7-14, fig. (1)) comprising walls which separate the upper liquid and lower liquid from liquid (10), and which extend into liquid (10), reading on the partition wall of instant claim 1.

The Lindauer reference differs from the instant application in that it does not teach the limbs of instant claim 2. However, these limitations are deemed to be a matter of engineering design choice, and thus do not serve to patentably distinguish the

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claimed subject matter over the prior art. *In re Kuhle*, 526 F. 2d. 553, 188 USPQ 7 (CCPA 1975).

The Lindauer reference is silent with respect to the mixing or migrating of phases recited in instant claims 1 and 2, as well as the evaporation properties of instant claims 15 and 19. Applicant's article is the same as the prior art. It contains the same components in the same configuration. Properties are the same when the structure and composition are the same. Thus, burden shifts to applicant to show unexpected results, by declaration or otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the claimed properties would have been present once the composition was employed in its intended use. *In re Best*, 195 USPQ 433.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to make a vapor releasing article comprising a first phase, a second phase, and a third phase, which constitutes a barrier between the first and second phases, as taught by Lindauer, in view of Benko, further in view of Dunterloo. One of ordinary skill in the art at the time the invention was made would have been motivated to make such an article because it can deliver different substances (i.e. different aroma profiles) to the environment in a sequentially timed fashion, as explained by Lindauer.

* * * * *

Response to Arguments

Applicant's arguments filed on 30 January 2009 have been fully considered but they are not persuasive.

Applicant argues, "[t]here is minimal, if any, simultaneous evaporation of the first and second volatile substances in the present invention." See remarks, first page.

Examiner respectfully submits that simultaneous evaporation of the first and second volatile substances is not precluded from the instant application as currently claimed. Claim 1 only requires that the second phase commence vaporization substantially at the point which vaporization of the first phase is complete. Implied in the cited language is the fact that at some point in the evaporation process, simultaneous evaporation of the first phase and second phase will occur. This is verified in the instant specification, at page 9, lines 2-6, which states, "[w]hen the first and second phases are liquids and the article is designed such that when the second phase passes the third phase there is some of the first phase left..." Thus, mixing of the first and second phases will result in simultaneous evaporation of the first and second phases, as recited in the instant specification.

Applicant argues, "Lindauer...teaches only a random evaporation of the second phase once it has been slightly exposed by evaporation of the third phase." See remarks, second page.

Examiner respectfully disagrees that the evaporation of the first and second phases of the Lindauer invention are random. In fact, Lindauer explicitly states that his invention is, "...constructed in order to deliver, in sequentially timed fashion, to the environment surrounding the article...perfumes having different aroma profiles, insect repellents which repel different insects..." See col. 2, line 67 - col. 3, line 4, emphasis supplied.

As explained by Lindauer at, e.g., col. 4, lines 16-25, the disclosed invention provides a system of vaporization that is sequential and controlled.

The "...first matrix layer initially evolves said first volatizable substance at a rate substantially greater than the rate at which said second matrix layer evolves said second volatizable substance until such point in time that sufficient first volatizable substance has been evolved into the environment surrounding said article, that a substantial portion of said second inner surface is at least constructively exposed to the surrounding environment thereby permitting a substantial increase in the rate of emission of said second volatizable substance."

Thus, vaporization of the second phase of the Lindauer article commences substantially only when vaporization of the first phase has phased out, as that is when the second phase is maximally exposed to the environment. This results in control of vaporization rates. As such, the Lindauer reference reads on the instant application as currently claimed.

Applicant cites col. 9, lines 37-43 of Lindauer to make the point that Lindauer teaches simultaneous emanation of the first and second volatile substances. See remarks, paragraph bridging second and third pages.

As explained above, examiner respectfully submits that the instant claims do not preclude simultaneous emanation of the first and second phases. Lindauer teaches a gradient in which the second phase maximally evaporates when the first phase is consumed and when the third phase gel has shrunk, exposing the second phase

maximally (see above). As such, the Lindauer reference reads on the instant application as currently claimed.

Applicant argues that reference to Lindauer's figure 2 is confusing. See remarks, third page.

Examiner respectfully submits that fig. 2 was cited merely to show that evaporation of the second phase is maximal when the first phase is minimal since at that point, the gel of the third phase has maximally shrunk, leading to maximal exposure of the second phase to the environment, as explained at col. 4, lines 16-25 and col. 7, line 65 – col. 8, line 4 of Lindauer.

☆

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1615

/Humera N. Sheikh/
Primary Examiner, Art Unit 1615